

AMENDMENT & RESPONSE UNDER 37 C.F.R. § 1.116 - EXPEDITED PROCEDURE
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Filing Date: July 31, 1997
Title: AUDIO AND VIDEO CONTROLS ON A POINTING DEVICE FOR A COMPUTER

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wherein the volume control is operable without regard to orientation of the pointing device.

22. (New) The pointing device of claim 21, wherein the volume control comprises a wheel control.

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on September 19, 2001, and the references cited therewith.

Claims 1, 8, 12, and 16 are amended; claims 19-22 are added; as a result, claims 1-22 are now pending in this application.

§102 Rejection of the Claims

Claims 1-4 and 8-18 were rejected under 35 USC § 102(e) as being anticipated by Schultheiss (U.S. 6,208,384).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully traverses the rejection and submits that claims 1-4 and 8-18 are not anticipated by Schultheiss, because Schultheiss does not teach all elements of these claims.

Schultheiss does not teach or suggest all elements of claims 1-4. Amended claims 1-4 recite a "computerized system" that includes "a computer" and "a pointing device . . . having at least one control to control only the multimedia device . . . and wherein the pointing device further includes a second control operative to control a second multimedia device through the

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computer.” Schultheiss does not teach or suggest a pointing device that includes a second control operative to control a second multimedia device operatively coupled to a computer. Schultheiss discloses “system 10 [that] includes a personal computer 12, a television 40 and a wireless remote control 50.” *Column 4, lines 57-59; Figure 1*. In a different embodiment, Schultheiss further discloses “television interface 200.” *Column 7, lines 18-; Figure 4*. However, television interface 200 “receives television remote control signals 70b and television video signals 70a” from the personal computer. *Id.* Therefore, Schultheiss does not teach or suggest a pointing device having a second control operative to control a second multimedia device through the computer, because wireless remote control 50 controls only a single multimedia device (television 40).

Schultheiss does not teach or suggest all elements of claims 8-11. Amended claims 8-11 recite a “computerized system” that includes “a pointing device . . . wherein the pointing device further includes a second control operative to control a second multimedia device through the computer.” Schultheiss does not teach or suggest a pointing device that has a second control operative to control a second multimedia device through the computer, because wireless remote control 50 controls only a single multimedia device (television 40).

Schultheiss does not teach or suggest all elements of claims 12-15. Amended claims 12-15 recite a “pointing device” having “a second control disposed within the housing to control a second multimedia device through the computer.” Schultheiss does not teach or suggest a pointing device having a second control disposed within the housing to control a second multimedia device through the computer, because wireless remote control 50 controls only a single multimedia device (television 40).

Schultheiss does not teach or suggest all elements of claims 16-18. Amended claims 16-18 recite “a pointing device” having “a third control coupled to the device operative to control a second multimedia device through the computer, wherein the second multimedia device is operatively coupled to the computer.” Schultheiss does not teach or suggest a pointing device having a third control coupled to the device operative to control a second multimedia device through the computer, wherein the second multimedia device is operatively coupled to the computer, because wireless remote control 50 controls only a single multimedia device

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(television 40).

For the reasons stated above, Applicant submits that claims 1-4 and 8-18 are not anticipated by Schultheiss under 35 USC § 102(e), and respectfully requests reconsideration and allowance of these claims.

§103 Rejection of the Claims

Claim 5 was rejected under 35 USC § 103(a) as being unpatentable over Schultheiss as applied to claim 1 above, and further in view of Frank (EP 1,596 594).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation in the references or in the knowledge generally available to one of ordinary skill in the art to modify a reference or to combine reference teachings to arrive at the claimed invention. Third, there must be a reasonable expectation of success. M.P.E.P. § 2142. Applicant respectfully submits that the cited art does not present a *prima facie* case of obviousness, because even if combined, Schultheiss and Frank do not teach or suggest each and every element of claim 5.

Claim 5 recites a "computerized system" having a "pointing device . . . wherein the pointing device further includes a second control operative to control a second multimedia device through the computer." Schultheiss does not teach or suggest the pointing device of claim 5, because wireless remote control 50 controls only a single multimedia device (television 40). Frank also does not teach or suggest the pointing device of claim 5. Frank discloses a "[h]ost computer 34 [that] provides a user the ability to select among a plurality of operating modes for control device 30." *Column 5, lines 36-38*. As stated further in Frank,

"When the user selects either the remote control or the learn mode, control device 30 will operate as a remote control device. When used as a remote control device, the bottom of control device 30 is directed at a target device, such as target device 48 or 50."

Column 5, lines 43-48. Control device 30 of Frank communicates directly with target devices (such as target devices 48 or 50) in the remote control or learn mode, not through the computer. Therefore, neither Schultheiss nor Frank, alone or in combination, teach or suggest each and

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every element of claim 5. Applicant respectfully requests withdrawal of the rejection of claim 5.

Claims 6 and 7 were rejected under 35 USC § 103(a) as being unpatentable over Schultheiss as applied to claim 1 above, and further in view of Redford (U.S. 5,339,095). Applicant respectfully submits that the cited art does not present a *prima facie* case of obviousness, because even if combined, Schultheiss and Redford do not teach or suggest each and every element of claims 6 and 7.

Claims 6 and 7 each recite a "computerized system" having a "pointing device . . . wherein the pointing device further includes a second control operative to control a second multimedia device through the computer." As already stated, Schultheiss does not teach or suggest the pointing device of claims 6 and 7, because wireless remote control 50 controls only a single multimedia device (television 40). Redford also does not teach or suggest the pointing device of claims 6 and 7. Redford discloses a system having "a handheld remote unit 10 and a separate base unit 12 connected to a computer 14 which drives a display 16." *Column 3, lines 26-28*. As disclosed, there are no multimedia devices separate from the multimedia computer in Redford. Redford does not teach or suggest a pointing device operatively coupled to a computer and having at least one control to control only a multimedia device, wherein the pointing device only couples to the computer. Redford also does not teach or suggest a pointing device further including a second control operative to control a second multimedia device through the computer.

The cited art does not present a *prima facie* case of obviousness under 35 USC §103. Therefore, Applicant respectfully requests reconsideration and allowance of claims 5-7.

New Claims

Applicant has added new claims 19-22. These new claims do not add new matter, and are fully supported by the original disclosure. Applicant respectfully requests consideration and allowance of these new claims.

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Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-371-2169) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

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By



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The undersigned hereby certifies that this correspondence is being transmitted by facsimile (FAX NO. 703-872-9314) addressed to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 19th day of February, 2002.

Candis B. Buending

Name

Signature

